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09/940,236	08/27/2001	Gilbert Garitano	DERMA-06458	4147

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EXAMINER

DICUS, TAMRA

ART UNIT

PAPER NUMBER

1774

DATE MAILED: 06/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/940,236

Applicant(s)

GARITANO, GILBERT

Examiner

Tamra L. Dicus

Art Unit

1774

-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Response to Amendment***

The 112 rejections over “composition” and the trademarked terms are maintained. The 102 and 103 rejections are withdrawn.

### ***Claim Objections-Double Patenting***

1. Claim 15 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 1. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

2. Applicant is advised that should claim 1 be found allowable, claim 15 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear how a “corresponding transfer image”, as disclosed in the specification,

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is "a dye in the transfer medium that could be used to form a fixed image". It is unclear if a dye or a transfer medium is actually present in claim 1.

5. Claims 1-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. While applicant may be his or her own lexicographer, a term in a claim may not be given a meaning repugnant to the usual meaning of that term. See *In re Hill*, 161 F.2d 367, 73 USPQ 482 (CCPA 1947). The term "composition" in the preamble of claims 1-30 is used by the claim to mean "composition" while the accepted meaning is "laminate". The invention does not pertain to a composition, but an article of manufacture. For purposes of examination, the Examiner interprets the term "composition" in the preamble of all claims to mean a laminate.

6. Additionally, regarding claims 1-29, it is not clear as to if CORIAN®, GIBRALTAR®, FOUNTAINHEAD®, AVONITE®, or CERATA®, is added in addition to a filled polymeric material, or that it actually is the filled polymeric material. The term "filled" in itself is unclear as it is an indefinite term and not defined in the specification. Also, the use of trademarked terms in claims does not identify or describe the goods associated with the trademark or trade name. Trademarks or trade names are used to identify a source of goods, and not the goods themselves. See MPEP 2173.05(u). Replacement of trademarked terms with a generic description is advised.

#### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for

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patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claim 15 and 24-28 are rejected under 35 U.S.C. 102(e) as being anticipated by USPN 6,409,870 to Duffney.

9. Duffney teaches decorative molding/casing. Duffney teaches the molding/casing made from plastic, metal, Corian, Fountainhead, Surrell, and/or Avonite material (col. 2, lines 42-47) (equivalent to claim 15(a)) having designs on the front face section of the mold (col. 2, lines 25-30) (equivalent to claim 15(b)). The optical density value of the fixed image is inherent since the same materials are taught.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-8, 14, 16-23, 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,409,870 to Duffney in view of USPN 6,203,911 to Weberg et al. and USPN 5,747,154 to Minghetti et al.

12. Duffney teaches decorative molding/casing. Duffney teaches the molding/casing made from plastic, metal, Corian, Fountainhead, Surrell, and/or Avonite material (col. 2, lines 42-47) (equivalent to part (a)) having designs on the front face section of the mold (col. 2, lines 25-30) (equivalent to part (b)). Duffney does not teach the fixed image having a "corresponding transfer image", which defined in the disclosure as dye on a media such as heat transfer if a dye is used.

However, Minghetti teaches an acrylic sheet having uniform coloring and mineral filler for thermoforming plastics. Minghetti teaches dye and/or pigments may be incorporated with PMMA and Corian at col. 3, lines 42-68 and col. 4, lines 1-11, as they are conventional additives known in the art. Hence, it would have been obvious to one of ordinary skill in the art to modify the molding of Duffney to include dye as taught by Minghetti cited above because dye is a conventional additive in the art. The optical density value of the fixed image to the "corresponding transfer image" is inherent since the same materials are taught.

Duffney does not teach adding inorganic fillers in the specific composition as in claims 6-8 and 22. However, Weberg teaches inorganic fillers such as alumina trihydrate can be included in a polymeric material of PMMA from 10 to 75 weight % at col. 8, line 36. Hence it would have been obvious to one of ordinary skill in the art to modify the mold of Duffney to include alumina trihydrate because the addition increases the strength of a molded article as taught by Weberg at col. 8, lines 1-2 and appearance via refractive indices adjustments also taught by Weberg at col. 8, lines 30-35.

Duffney does not teach the compositions of the aforementioned trademarked terms, however such terms encompass the ingredients, their amounts, and associated properties of instant claims 2-14, 16-28, and 30. Further, Weberg teaches the composition of filled acrylic resins of instant claims 2-14, 16-28, and 30 for article designs. See col. 1, line 59, col. 8, line 36, col. 24, line 42, and col. 25, line 19. Hence, it would have been obvious to one of ordinary skill in the art to modify the invention of Duffney to include a filled polymeric material in an image to adjust the refractive indices for aesthetic reasons as taught by Weberg at col. 8, lines 30-34.

***Response to Arguments***

13. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection. Wang is still used to show the Corian compositions and additives.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is (703) 305-3809. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-8329 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Tamra L. Dicus  
Examiner  
Art Unit 1774

June 11, 2003

CYNTHIA H. KELLY  
SUPERVISORY PATENT EXAMINER  
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